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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAN WEBER

Appeal 2009-006388
Application 10/084,857
Technology Center 3700

Before: WILLIAM F. PATE III, MICHAEL W. O'NEILL, and
FRED A. SILVERBERG, *Administrative Patent Judges*.

PATE III, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 1, 2, 4-8, 11, 12, 20-26, 28, 29, and 42-49. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

The claims are directed to non-invasive heating of an implanted vascular treatment device. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A vascular treatment device, comprising:

a stent formed with a magnetically susceptible material having a magnetic susceptibility that decreases within a preselected temperature range.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Garibaldi	US 6,364,823	Apr. 2, 2002
Doscher	US 6,786,904	Sep. 7, 2004

REJECTIONS

Claims 1, 2, 4-7, 20-25, 43 and 47 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Garibaldi. Ans. 3.

Claims 8, 11, 12, 26, 29, 42, 44-46, 48 and 49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Garibaldi. Ans. 4.

Claim 28 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Garibaldi and Doscher. Ans. 5.

OPINION

While we agree with Appellant that the patch embodiment 120 of Garibaldi shown in Figure 12A is not usable with the embolic composition disclosed starting at column 11, we agree with the Examiner that the magnetic patch embodiment shown in Figure 12A and exemplified by the nitinol patch 120 is evidence that the subject matter of claim 1 lacks novelty. When Appellant's claim 1 is given its broadest reasonable construction, there is no limitation on the scope of the claim term "preselected temperature." Thus, we are in agreement with the Examiner that the preselected temperature could be any temperature range known in the prior art.

Appellant has admitted in the Reply Brief dated October 30, 2008 that the magnetic susceptibility of the iron particles in the Figure 12A disclosed embodiment is at a Curie temperature of about 770 ° C. *See Reply Br. 12, ll. 1-4.* Furthermore, Garibaldi discloses that a stent-like structure could be constructed of several patches that would collectively form an interior wall section like a stent. *See col. 8, ll. 47-61.* Thus, we agree with the Examiner's statement, quoted on page 16 of the October 30, 2008 Reply Brief that claim 1 does not require anything further than a stent formed with a magnetically susceptible material. It is our legal conclusion that the Examiner's claim construction is correct, and that his finding that Garibaldi discloses a stent with a magnetic susceptibility that has a Curie temperature in a preselected range is not erroneous. Therefore, it is our finding that claim 1 lacks novelty over the Garibaldi reference.

Appellant argues on pages 16 and 17 of the October 30, 2008 Reply Brief that Garibaldi does not teach a stent formed with magnetically susceptible material. However, Garibaldi is quite clear that a stent

consisting of several patches arrayed around the inner periphery of a blood vessel is formed by the method of the invention. Furthermore, these patches all are coated with a magnetic material and, as the Examiner so succinctly puts it, these magnetic materials all have a Curie point.

Claims 2 and 4-7 have not been separately argued. Therefore, these claims fall with claim 1.

The Appellant's argument with respect to combining the two embodiments is convincing in that Garibaldi does not contemplate joining these two embodiments. However, that is not the only rejection posited by the Examiner. As we have noted, the Examiner has rejected claims 1, 2, 4-7, 20-25, 43 and 47 as anticipated by Garibaldi and specifically the Figure 12A embodiment thereof.

Turning to a consideration of independent claim 20, we do not affirm the 35 U.S.C. § 102 rejection of this claim. Appellant is correct in that the magnetic feature of the patch embodiment is to steer and place the patch embodiment in the desired location. There is no disclosed "heating for treatment" with respect to this embodiment used alone. Therefore, the rejection of claim 20 is not sustained. We also reverse the rejections of claims 21-26, 28, 29 and 46-49 whether under § 102 or § 103. The subject matter of these claims is neither anticipated nor unpatentable under Garibaldi.

With respect to claims 8, 11, and 12, we do not sustain the rejection of these claims. First, the Examiner has not provided an articulated reason with rational underpinnings for the use of gadolinium in the Figure 12A embodiment of Garibaldi. Likewise, the Examiner has not convinced us of any rationale which would have rendered the use of the ferrite oxide or

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chromium oxide of claim 12 in the Figure 12A embodiment of Garibaldi. Therefore the rejection of claims 8, 11 and 12 cannot be sustained.

Finally, the rejections of claims 42 and 43, separately argued by the Appellant, are not affirmed. The details by which magnetic material is incorporated into the patch 120 in the Figure 12A embodiment of Garibaldi are insufficient to sustain an anticipation or obviousness rejection of these claims.

DECISION

The rejections of claims 1, 2, and 4-7 under 35 U.S.C. § 102 is affirmed.

The rejection of claims 20-25, 43 and 47 under 35 U.S.C. § 102 is reversed.

The rejection of claims 8, 11, 12, 26, 28, 29, 42, 44-46, 48 and 49 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

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